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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/122,740	07/27/1998	KAZUHIRO TOMIZAWA	614.1907	4749

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EXAMINER	
FLEURANTIN, JEAN B	

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/122,740	TOMIZAWA, KAZUHIRO	
	Examiner	Art Unit	
	JEAN B. FLEURANTIN	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8,12,14-16 and 23-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1,3-8 and 23-25* is/are allowed.

6)☐ Claim(s) *12, 14-16 and 26-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This is in response to Applicant(s) arguments filed on 23 February 2005. Claims 23-28 are added.

2. Claims 1, 3-8, 12, 14-16 and 23-28 remain pending for examination. Newly added claims 23-28 are discussed in the following rejection.

Information Disclosure Statement

3. The information disclosure statement (IDS) filed 11/30/04 complies with the provision of M.P.E.P. 609. It has been placed in the application file. The information referred to therein has been considered as to merits. (See attached form).

Response to Applicant' Remarks

4. Applicant's arguments filed 23 February 2005 have been fully considered but they are not persuasive for the following reasons, see sections A and B.

Claim Rejections - 35 USC § 103

A. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12, 14-16 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,661,800 issued to Nakashima et al. ("hereinafter Nakashima") in view of U.S. Patent No. 5,423,034 issued to Cohen-Levy et al. ("hereinafter Cohen-Levy").

As per claim 12, Nakashima discloses "an information processing apparatus, storing a plurality of applications at ~~locations~~ addresses of a computer-readable storage" (see col. 16, lines 8-12), comprising:

"a directory structure in the storage corresponding to the plurality of applications" (see col. 9, lines 1 -4);

"wherein in the computer-readable storage information of the of the application addresses are directly given to predetermined directories of the directory structure, respectively" (see col. 10, lines 37-40),

"the application address information being for identifying the applications, respectively" (see col. 5, lines 64-65),

"wherein an address of the plurality applications are the items of identification information" (see col. 16, lines 8-12). Nakashima fails to explicitly disclose where the

~~of~~ applications are needed for corresponding data files, and where the data files are organized and stored in the computer-readable storage using the predetermined directories of the directory structure. However, Cohen-Levy discloses predetermined directory name will identify those storage devices that contain information recognized by the real world hierarchical data structure and will determine which directories of those storage devices contain recognized information (see col. 12, lines 53-63). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combined teachings of Nakashima and Cohen-Levy with applications are needed for corresponding data files stored in the storage using the predetermined directories of the directory structure. Such modification would allow the teachings of Nakashima and Cohen-Levy to provide the user with an interface to enable the user of the application program to communicate with the program (see Cohen-Levy col. 1, lines 62-64).

As per claim 14, Nakashima discloses, "an application management table that stores the items of identification information and starting addresses of the plurality of applications, the plurality of applications corresponding to the items of identification, respectively (col. 4, lines 6-41).

As per claim 15, Nakashima discloses, "wherein an item of the items of identification information is given to the highest directory of the directory structure" (see col. 4, lines 6-30).

As per claim 16, discloses, the limitations of claim 16 are rejected in the analysis of claim 12, and this claim is rejected on that basis.

As per claim 26, Nakashima discloses, "wherein the directories are predetermined" (see col. 4, lines 14-53).

As per claims 27 and 28, Nakashima discloses, "wherein the memory card comprises an IC card" (see Figure 3, col. 4, lines 45-53).

Allowable Subject Matter

i) The following is a statement of reasons for the indication of allowable subject

As per claims 1, 3-8 and 23-25, the claimed features "electronically performing management so that when one of the data files is selected a needed application corresponding to the data file's a directory of the directories is automatically selected and executed by referring to the selected data file's directory to obtain its application's address information and therewith access and execute the application at the computer-readable storage location of the thus-obtained address information given to the directory, where the selection for execution is responsive to the data file of the directory being selected" in conjunction with other elements of the independent claims are not found as anticipated or obvious over the prior art made of record.

B. In response to applicant's argument, page 9, paragraphs 2 and 3, that "In the Office Action, at pages 4-5, claims 1, 3-8, 12, and 14-16 were rejected under 35 U.S.C. a 101 because the claimed invention is directed to non-statutory subject matter. The claims have been amended to clarify that they are directed to the use of a computer, a computer method, a storage for use with a computer, etc. For example, "storage" is now "computer-readable storage". As stated in MPEP 2106, "when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases". Withdrawal of the rejection is respectfully requested." As the amendment(s) overcome the 35 U.S.C. 101 rejection of claims 1, 3-8, 12 and 14-16. Therefore, the rejection has been withdrawn.

In response to applicant's argument, page 10, paragraph 4, that "Nakashima's table of media addresses is not for storing and organizing data files, and no addresses are mentioned or suggested. Although claims are to be interpreted as broadly as reasonably possible, they are also to be interpreted as they would be understood by one skilled in the art. One skilled in the art of computer programming would not interpret a directory for storing and organizing files as equivalent to a table of program locations." rejection is respectfully requested." the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, Nakashima discloses the claimed limitation(s) as follow: "an information processing apparatus, storing a plurality of applications at ~~locations~~ addresses of a computer-readable storage" (see col. 16, lines 8-12), comprising:

"a directory structure in the storage corresponding to the plurality of applications" (see col. 9, lines 1 -4);

"wherein in the computer-readable storage information of the of the application addresses are directly given to predetermined directories of the directory structure, respectively" (see col. 10, lines 37-40),

"the application address information being for identifying the applications, respectively" (see col. 5, lines 64-65),

"wherein an address of the plurality applications are the items of identification information" (see col. 16, lines 8-12). Nakashima fails to explicitly disclose where the ~~of~~ applications are needed for corresponding data files, and where the data files are organized and stored in the computer-readable storage using the predetermined directories of the directory structure. However, Cohen-Levy discloses predetermined directory name will identify those storage devices that contain information recognized by the real world hierarchical data structure and will determine which directories of those storage devices contain recognized information (see col. 12, lines 53-63). It would have been obvious to a person of ordinary skill in the art at the time the invention was made

to modify the combined teachings of Nakashima and Cohen-Levy with applications are needed for corresponding data files stored in the storage using the predetermined directories of the directory structure. Such modification would allow the teachings of Nakashima and Cohen-Levy to provide the user with an interface to enable the user of the application program to communicate with the program (see Cohen-Levy col. 1, lines 62-64).

In response to applicant's arguments, pages 8-10, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecussion and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a

court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the last Office Action was proper.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean Bolte Fleurantin

Patent Examiner

Technology Center 2100

May 08, 2005

SHAHID ALAM
PRIMARY EXAMINER